

Request for Reconsideration
Under 37 C.F.R. § 1.116
Date: April 1, 2008

Serial No. 10/763,449
Atty. Docket No. GP106-11.DV4

Remarks

Claims 1-32 are presently pending in the subject application. Reconsideration and allowance in view of the following remarks are respectfully requested.

Rejections Under 35 U.S.C. § 103

The claims stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over McGregor *et al.* (U.S. Pat. No. 4,808,381), alone or in combination with any one or more of Roach (U.S. Pat. No. 3,494,201), Sandhage (U.S. Pat. No. 2,906,423), Koch *et al.* (U.S. Pat. No. 5,578,272), and Percaprio (U.S. Pat. No. 4,338,764). Applicants respectively traverse these rejections for the reasons previously presented and for the reasons that follow.

The Examiner's patentability rejections all rely upon the conclusion that the transfer device of McGregor anticipates the fluid transfer device of the instant application. *See* Office Action at paragraph 2 ("Examiner takes the position that this transfer device anticipates the fluid transfer device of the instant application."). To support this conclusion, the Examiner references column 4, lines 49-59 of McGregor for disclosing a fluid transfer device having a cannula for piercing a stopper and contacting and withdrawing fluid from a receptacle. This characterization of McGregor's transfer device (12) is flatly contradicted by the very section referenced by the Examiner. In this section, McGregor teaches that after the cannula (30) has passed through the closure (18), suction members (14, 14') having stems (24, 24') are inserted through the cannula (30) and contact different layers (20a, 20) contained in a receptacle (10). Thus, as illustrated in Figures 1-3 of McGregor, it is the stems (24, 24') of the suction members (14, 14') – not the cannula (30) of the transfer device (12) as urged by the Examiner – that contact and draw fluid from within the receptacle (10) after the closure (18) has been pierced. Additionally, it is clear that the transfer device (12) and the suction members (14, 14') of McGregor are structurally distinct from each other

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and, therefore, cannot be construed as constituting a single device, as is required by the claims of the instant application.

Unlike McGregor, the claimed methods require that the fluid transfer device used to draw and remove a fluid substance from a fluid-holding vessel is the same fluid transfer device used to puncture a surface of an associated cap. Claims 3 and 23, which depend from claims 1 and 21, respectively, further specify that the fluid transfer device of each of the recited steps is a plastic pipette tip. To suggest that the claimed methods for accessing the contents of a fluid-holding vessel and that of McGregor are equivalents would require dispensing with an essential component of McGregor's method, the use of the transfer device (12) to puncture a closure (18) and, thereby, provide a conduit for a suction member (14, 14') to access to the contents of a vessel (10). *See In re Ratti*, 123 USPQ 349, 352 (CCPA 1959)(the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference]").

For these and other reasons, Applicants submit that McGregor does not provide a *prima facie* case of obviousness when considered alone or in combination with any of the other cited references. Accordingly, withdrawal of the Examiner's patentability rejections is respectfully requested.

Conclusion

Based on the amendments and remarks, Applicants submit that the presently pending claims are in condition for allowance and notice to that effect is hereby respectfully requested.

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No fee is believed due in connection with this Request. If Applicants are mistaken, then please charge any amounts due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Respectfully submitted,

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